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In re Application of
CHANDRASIRI, et al.
Serial No.: 10/580,297
PCT No.: PCT/GB04/04711
Int. Filing Date: 05 November 2004
Priority Date: 19 November 2003
Atty Docket No.: 16458.7
For: NETWORKS

DECISION ON PETITION

UNDER 37 CFR 1.47(a)

This decision is in response to the petition under 37 CFR 1.47(a) filed 22 October 2007 to accept the application without the signature of joint inventor Pubudu Chandrasiri.

BACKGROUND

On 05 November 2004, applicant filed international application PCT/AU02/01752 which claimed priority to a previous application filed 19 November 2003. A copy of the international application was transmitted to the United States on 09 June 2005. Pursuant to 37 CFR 1.495 the period for providing payment of the full, U.S. Basic National Fee was set to expire thirty months from the priority date, or midnight 19 May 2006.

On 19 May 2006, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 21 March 2007, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) indicating that an executed oath or declaration of the inventors was required, as well as, payment of the \$130.00 surcharge for providing an executed oath or declaration later than thirty months from the earliest claimed priority date. Applicant was afforded two months to file a proper response.

On 22 October 2007, applicant filed the present petition under 37 CFR 1.47(a) accompanied by a petition for a five-month extension of time and payment of the appropriate extension fee. Therefore, applicant's response is considered timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicant has satisfied items 1 and 3.

As to item (2), as stated in the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal, "Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature." According to the filed declaration of Mr. David Keston, the non-signing inventor were merely mailed a combined declaration and power of attorney rather than a complete set of application papers. As such, the subsequent silence cannot be considered a refusal under 37 CFR 1.47(a). In addition, it appears that attempts have been made to locate a current address for the non-signing inventor. As explained further in Section 409.03(d), in order to show a diligent effort to locate an inventor, "Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts." While applicant references searches made by Mr. Keston, these results have not been included with the present petition.

Regarding item 4, applicant has provided a declaration executed by the remaining inventors. However, the declaration is not in compliance with 37 CFR 1.497 (a)-(b). Manual of Patent Examining Procedure (MPEP) Section 201.03 explains:

An oath or declaration under 37 CFR 1.63 by each actual inventor must be presented. While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration.

The filed declaration contains three pages four of five. As such, it appears that the inventors were not provided with complete declarations for signature or only returned the signature pages. Either scenario renders the documents non-compliant.

In light of the above, it is not possible to grant applicant's petition at this time.

CONCLUSION

For the reasons stated above, applicant's petition under 37 CFR 1.47(a) is DISMISSED.

Any reconsideration on the merits of this petition must be filed within **TWO (2)**

MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink, appearing to read 'Derek A. Putonen', is positioned above the typed name.

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